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Serial no. 09/883,621
Filed 6/18/2001
Attorney docket no. 10012116-1

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REMARKS

First Note: All pending claims have *not* been examined

The current office action indicates that claims 1-20 have been rejected. However, no discussion is provided as to the rejection of claims 7, 10-13, 16, and 18. Applicant presumes that the Examiner inadvertently indicated these claims as rejected, when they should have been allowed. If so, Applicant thanks the Examiner. If these claims should have been rejected, however, Applicant requests that the reasons why they are rejected be detailed in the next office action. Applicant also notes that because no reasoning was provided as to why these claims were rejected in the current office action, *it would be improper and unfair to Applicant to issue a final office action as the next office action, when Applicant has not had an opportunity to rebut the Examiner's reasoning.*

In particular, in paragraph 3 of the current office action, claims 1-2 are rejected. Claims 3 and 19 are rejected in paragraph 4 of the office action. Paragraph 5 discusses the rejection of claims 4-5 and 14-15. Paragraph 6 discusses the rejection of claim 6. Claims 8-9, 17, and 20 are rejected in paragraph 7. Thus, claims 7, 10-13, 16, and 18 have not been rejected within the current office action.

Second Note: The Examiner has failed to consider Applicant's previous remarks

In the current office action, the Examiner merely notes that receipt is acknowledged of the amendment filed on April 30, 2003. However, the Examiner does not provide any reasoning as to why these remarks were not persuasive. This is particularly problematic because the Examiner relies on substantially the same prior art references in the current office action – such that the remarks provided by Applicant were decidedly not moot in view of the continued rejection of the claims by the Examiner. Therefore, Applicant again notes that *it would be improper and unfair to Applicant to issue a final office action as the next office action, where the Examiner has failed to consider Applicant's previous remarks yet relies on substantially the same prior art references and reasoning in the current office action.*

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Claims 1-2: Section 103(a) Rejection

Claims 1-2 have been rejected under 35 USC 103(a) as being unpatentable over Carroll (5,266,944) in view of Lyons (6,411,209) and Bursell (5,993,001). Claim 1 is an independent claim, from which claim 2 depends. Applicant asserts that claim 1 is not rendered obvious over the cited prior art, and presents two separate and independent bases for the patentability of claim 1. First, Lyons is not properly combined with Carroll, such that a *prima facie* case of obviousness has not been made. Second, Bursell is not properly combined with Carroll in view of Lyons, such that a *prima facie* case of obviousness has not been made. Claim 2, as a dependent claim, is patentable for at least these same reasons that independent claim 1 is. Applicant now discusses in detail each of these separate and independent bases for patentability.

Lyons is not properly combined with Carroll

The Examiner has cited Carroll as teaching a camera and a detection mechanism to cause the camera to take one or more photos of a person, in response to detection of an event; Lyons as teaching a digital camera and a face detection and selection mechanism to determine the best photo of the one or more photos; and Bursell as teaching a database to store the best photo of the person with at least a current date in which the best photo was taken.

However, with specific respect to the Examiner's combining Lyons with Carroll so that the system of Carroll includes a face detection and selection mechanism, Applicant notes that section 2143.01 of the MPEP states that "the prior art must suggest the desirability of the claimed invention." More specifically,

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(*Id.*) There is no explicit or implicit motivation to combine Lyons with Carroll to include a face detection and selection mechanism.

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In the context of a surveillance system like that of independent claim 1, the application as filed notes that at least some embodiments of the invention provide for certain advantages when used in the context of the premises of a store, thus representing the desirability of the claimed invention.

Rather than having to review several days worth of video tape from a video surveillance system, a user only has to scroll through the various faces stored in the database during a period of time, which is likely to be less time-consuming. . . . [T]he user may be able to search for the photo of the face of a desired person based on what has been purchased by him or her.

(P. 2, ll. 21-25, through p. 3, ll. 1-4) Having a face detection and selection mechanism thus is desirable in the claimed invention because it is likely to decrease the length of time for the user to review the photos of the faces of a number of persons that may have visited the premises of his or her store, in order to locate the photo of the face of a particular person (*e.g.*, to assist the authorities with finding the suspect in an attempted robbery, in case the suspect had previously cased the store during a previous, seemingly innocuous visit, and so on).

There is no comparable desirability in combining Lyons with Carroll to yield a system having a face detection and selection mechanism. Carroll is directed to

An electronic monitoring system that monitors an abuser for compliance with a protective order. When a violation is detected, the system automatically gathers evidence, independent of any that may be provided by the victim of the abuse, to establish probable cause of such violation.

(Abstract) The desirability of combining Lyons with Carroll to provide a face detection and selection mechanism is negligible at best. The electronic monitoring system of Carroll is meant to record a violation of an already known particular abuser of a protective order. There is no motivation to also include a face detection and selection mechanism by combining Lyons with Carroll so that, for instance, a particular face of a desired unknown person is easily found among the faces of a large number of unknown persons.

For example, in the case of a battered wife having sought a protective order against her estranged husband, there is no need to have a face detection and selection mechanism to identify the estranged husband and select the best photo of his face so that he can be easily recognized. The estranged husband would already be known – by the battered wife at least,

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and certainly by the fact that he has a uniquely identifiable transmitter bracelet attached to his leg, as shown in FIG. 2 of Carroll. In such cases, there will typically be only two faces in all the pictures of the husband and the wife, and the pictures will only be taken while the husband is violating the protective order. There is no motivation to combine Lyons with Carroll to include a face detection and selection mechanism, because the authorities do not have to comb through days worth of pictures to find pictures of the husband.

Indeed, combining Lyons with Carroll frustrates the intended purpose of Carroll. The crux of Carroll is to automatically gather evidence, via the camera, when the abuser of the protective order has tripped the detection mechanism. It is at least seemingly reasonable that the goal would be to gather as much evidence as possible. Introducing a face detection and selection mechanism, as combining Lyons with Carroll does, would mean that the large amount of evidence gathered would be culled down to a single photo of the face of the abuser, from which the abuser is most easily recognized. However, the point of having the evidence is not to being able to easily identify the abuser per se, but rather to establish probable cause of the violation of a protective order.

Whittling down the pictures taken by the camera in Carroll to yield a single best photo of the face of the abuser would certainly not provide sufficient evidence of probable cause of the violation of the protective order by the abuser, although this is what combining Lyons with Carroll would require. Having only a single photo of the face of the abuser would more than likely provide *insufficient* evidence of probable cause, countering the entire point of having the electronic monitoring system of Carroll in the first place. Combining Lyons with Carroll thus destroys the intended functionality and purpose of Carroll.

As a result, the Examiner's reasoning in the current office action that Lyons is combinable with Carroll to "provide convenience and time savings to the user/operator, and to preserve memory space" does not make sense. Although convenience, time savings, and reducing memory utilization are laudable goals, they conflict with the utmost purpose of Carroll, to secure sufficient evidence of probable cause. That is, the incentives given by the Examiner to combine Lyons and Carroll cannot act as a motivation to combine where combining Lyons and Carroll destroys the *explicit* intended functionality and purpose of

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Carroll. Saving time, and preserving memory space, do not matter in Carroll if the end result is that there is insufficient evidence of probable cause of violation of a protective order. Therefore, the Examiner's reasoning for combining Lyons with Carroll is decidedly unpersuasive. *Applicant strongly submits that the Examiner's combination of Lyons with Carroll would not be sustained on appeal.*

Bursell is not combinable with Carroll in view of Lyons

As has been noted, the Examiner has cited Carroll as teaching a camera and a detection mechanism to cause the camera to take one or more photos of a person, in response to detection of an event; Lyons as teaching a digital camera and a face detection and selection mechanism to determine the best photo of the one or more photos; and Bursell as teaching a database to store the best photo of the person with at least a current date in which the best photo was taken.

It is dubious at best, however, that one of ordinary skill in the art would combine aspects of a stereoscopic imaging system for retinal examination, to which Bursell is directed, with the electronic monitoring system of Carroll and the security monitoring system of Lyons. Applicant notes that the invention of claim 1 is directed to a "surveillance system." As such, Bursell is non-analogous prior art to the claimed invention, and therefore is not combinable with Carroll in view of Lyons. Absent a clear motivation within the prior art to combine electronic monitoring systems with stereoscopic imaging systems for retinal examinations, Bursell cannot be combined with Carroll and Lyons.

Bursell is specifically directed to a stereoscopic imaging system for retinal examination. This is highly non-analogous to a surveillance system.

The Federal Circuit has noted that

[a] reference is reasonably pertinent if . . . it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

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In re Clay, 966 F.2d 656 (Fed. Cir. 1992) The Federal has also stated that

We have reminded ourselves and the PTO that it is necessary to consider “the reality of the circumstances” – in other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

In re Oetiker, 977 F.2d 1443 (Fed. Cir. 1992) Applicant asserts that one of ordinary skill within the art would not look to Bursell in addressing the problem that the claimed invention solves, nor is it common sense to look to Bursell in addressing the problem that the invention of claims 1, 11, and 18 solves.

The filed patent application describes the type of problems that are solved by the claimed invention.

[S]uch surveillance systems have some disadvantages. For example, if a theft has occurred, but the exact time of which is not known, several days worth of videotape may have to be reviewed to learn who has perpetrated the theft. This can be a very time-consuming and inconvenient process.

(P. 1, ll. 19-22) The invention of claim 1 solves these and other problems, as also recited in the filed patent application.

Rather than having to review several days worth of videotape from a video surveillance system, a user only has to scroll through the various faces stored in the database during a period of time, which is likely to be less time-consuming.

(P. 2, ll. 22-25)

By comparison, Bursell is directed to subject matter that is wholly unrelated – and non-analogous – as compared to the surveillance system of the claimed invention. Bursell is directed to a stereoscopic imaging system for retinal examination. The recited field of the invention of Bursell is that it “relates to systems and methods for examining and treating the eye, and more particularly, to . . . systems . . . that provide stereoscopic images of the retina of an eye.” (Col. 1, ll. 10-15) The background section in Bursell is also informative.

Diabetes is the leading cause of blindness in working age adults. It is disease that, among its many symptoms, includes a progressive impairment of the peripheral vascular system. These changes in the vasculature of the retina cause progressive vision impairment and eventually complete loss of sight.

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Accordingly, it would be desirable to implement more widespread screening for retinal degeneration or pathology, and to positively address the financial, social and cultural barriers to implementation of such screening. It would also be desirable to improve the efficiency and quality of retinal evaluation.

(Col. 1, ll. 15-22; col. 2, ll. 1-6)

Bursell is thus non-analogous to the surveillance system of claim 1. The surveillance system of the claimed invention has nothing to do with retinal examination. The surveillance system of the claimed invention has nothing to do with diabetes, or the peripheral vascular system. The surveillance system of the claimed invention has nothing to do with implementing eye screening, nor with improving the quality of retinal evaluations. As such, Bursell is improperly relied upon as analogous prior art to the claimed invention, and is not properly combined with Carroll in view of Lyons.

The Examiner's stated motivation for combining Bursell with Carroll in view of Lyons is that doing so would "provide date identification to the photo to further keep track of the photos with [the] date taken on it." Again, although this is a laudable goal, it does not lessen the non-analogous nature of Bursell to the surveillance system of claim 1, the electronic monitoring system of Carroll, and the securing monitoring system of Lyons. Non-analogous art cannot be combined with analogous art to yield the subject matter of an invention. ***Applicant strongly submits that the Examiner's combination of Bursell with Carroll in view of Lyons would not be sustained on appeal.***

Claims 3 and 19: Section 103(a) Rejection

Claims 3 and 19 have been rejected under 35 USC 103(a) as being unpatentable over Carroll in view of Lyons and Bursell, and further in view of Lee (5,151,945). Claim 3 is a dependent claim depending ultimately from independent claim 1. Therefore, claim 3 is patentable for at least the same reasons that claim 1 is patentable. Claim 19 is a dependent claim ultimately depending from independent claim 18. However, the Examiner has not provided any reasons for rejecting claim 18. Therefore, rejecting claim 19 by finding its

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additional limitations within the prior art, without having already found the limitations of the base independent claim, claim 18, from which claim 19 depends, is improper.

Claims 4-5 and 14-15: Section 103(a) Rejection

Claims 4-5 and 14-15 have been rejected under 35 USC 103(a) as being unpatentable over Carroll in view of Lyons and Bursell, and further in view of Clever (4,145,715). Claims 4-5 are dependent claims ultimately depending from independent claim 1, and therefore are patentable for at least the same reasons that claim 1 is. Claims 14-15 are dependent claims ultimately depending from independent claim 11. However, the Examiner has not provided any reasons for rejecting claim 11. Therefore, rejecting claims 14-15 by finding its additional limitations within the prior art, without having already found the limitations of the base independent claim, claim 11, from which claims 14-15 depend, is improper.

Furthermore, Applicant asserts that claims 4-5 and 14-15 are specifically independently patentable, irrespective of the patentability of claims 1 and 11 from which they depend. Claim 4 recites the detection mechanism being a cash register, such that ringing up a sale to the person on the cash register causes the digital camera to take one or more photos of the person. Claim 14 recites detecting a sale to the person having been rung up on a cash register as the event in response to which one or more photos of the person are taken. Claim 5 depends from claim 4, and claim 15 depends from claim 14. Therefore, claims 5 and 15 are patentable for at least the same reasons that claims 4 and 14 are patentable.

Applicant submits that Carroll in view of Lyons and Bursell, and further in view of Clever, do not disclose the invention of claims 4 and 14. The Examiner has stated that

Clever teaches a surveillance system having a camera used in conjunction with a cash register 14 at a point of sale transaction, where the functionality of the cash register is to ring up a sale to a person on the cash register for a transaction purpose.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to apply the detection mechanism of Carroll as modified by Lyons and Bursell to the point of sale transaction system as taught by Clever in order to obtain a clear image identification detection system in sale environment for the purpose of capturing the customer's identification and image record keeping Accordingly, it would have been an obvious

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modification as taught by Carroll as modified by Lyons and Bursell in applying a known system to other operations.

(Office Action, p. 5)

However, the Examiner has neglected to consider all the words in claims 4 and 14 in judging their patentability. Claims 4 and 14 are directed to the ringing up of a sale to a person on the cash register as causing the digital camera to take one or more photos of the person. The cash register is itself the detection mechanism. By comparison, Clever, while disclosing a cash register within a point of sale transaction environment, does not disclose the use of a sale itself on the cash register as causing pictures to be taken.

The Examiner has thus seemingly missed the point of claims 4 and 14 by failing to consider all their words. It is beside the point whether the detection mechanism of Carroll, as modified by Lyons and Bursell, is applicable to the point of sale transaction system as taught by Clever. The point of difference is that the detection mechanism of Carroll, as modified by Brennan and Bursell, does not disclose using a cash register – and the ringing up of a sale thereon – as the detection mechanism to cause photos of a person to be taken, nor does Clever teach such usage of a cash register and the ringing up of a sale thereon. Clever, and Carroll in view of Lyons and Bursell and further in view of Clever, do not render the invention of claims 4 and 14 obvious.

Applicant notes that the reasoning provided by the Examiner with respect to claims 4 and 14 is nearly identical to the reasoning provided in the earlier office action response. While the Examiner acknowledged the receipt of the earlier response, the Examiner has not particularly discussed this reasoning as to claims 4 and 14. The Examiner merely recited, nearly word for word, the same reasoning as provided in the first office action. Yet Applicant refuted this reasoning, as substantially duplicated above, without further comment by the Examiner. Merely resubmitting the previous arguments from an earlier office action in a new office action, however, is not proper, without some indication as to why the Examiner did not find Applicant's refutation of this reasoning improper – and the Examiner provided no comment on Applicant's reasoning. *Applicant strongly submits that the Examiner's rejection of claims 4-5 and 14-15 would not be sustained on appeal.*

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Claim 6: Section 103(a) Rejection

Claim 6 has been rejected under 35 USC 103(a) as being unpatentable over Carroll in view of Lyons and Bursell, and further in view of Monroe (6,366,311). Claim 6 is a dependent claim depending ultimately from independent claim 1. Therefore, claim 6 is patentable for at least the same reasons that claim 1 is patentable.

Claims 8-9, 17, and 20: Section 103(a) Rejection

Claims 8-9, 17, and 20 have been rejected under 35 USC 103(a) as being unpatentable over Carroll in view of Lyons and Bursell, and further in view of Kuperstein (6,128,398). Claims 8-9 are dependent claims ultimately depending from independent claim 1, and therefore are patentable for at least the same reasons that claim 1 is patentable. Claims 17 and 20 are dependent claims ultimately depending from independent claims 11 and 18. However, the Examiner has not provided any reasons for rejecting claims 11 and 18. Therefore, rejecting claims 17 and 20 by finding their additional limitations in the prior art, without having already found the limitations of the base independent claims, claims 11 and 18, from which claims 17 and 20 depend, is improper.

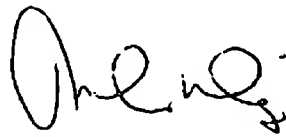
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Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Jim McDaniel, Applicants' Attorney, at 208-396-4095, or Mike Dryja, Applicants' Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



Nov 6, 2003
Date

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